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1   RECORD OF ORAL HEARING
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3   UNITED STATES PATENT AND TRADEMARK OFFICE
4   _____
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6   BEFORE THE BOARD OF PATENT APPEALS
7   AND INTERFERENCES
8   _____
9
10   *Ex Parte* DAVID L. BAHR, DOUGLAS W. BAHR,
11   MEENAL V. EKBOTE, and ALEXANDRE OKONECHNIKOV
12   _____
13
14   Appeal 2009-005331
15   Application 09/497,383
16   Technology Center 2400
17   _____
18
19   Oral Hearing Held: November 19, 2009
20   _____
21
22   Before MAHSHID D. SAADAT, CARLA M. KRIVAK,
23   and CARL W. WHITEHEAD, JR., *Administrative Patent Judges.*
24
25   ON BEHALF OF THE APPELLANTS:
26
27   JON M. JURGOVAN, ESQUIRE
28   Alston & Bird, LLP
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32
33   The above-entitled matter came on for hearing Thursday, November

34   19, 2009, commencing at 9:12 a.m., at the U.S. Patent and Trademark

35   Office, 600 Dulany Street, Alexandria, Virginia, before Deborah Courville, a

36   Notary Public.

1	P R O C E E D I N G S
2	MR. JURGOVAN: So, looking at the first two figures that I've
3	handed you, these are Figures 2 and 3 from the application as originally
4	filed. And what you see is there are basically three elements in the system.
5	There's a computer 10, there's a scanner 11 that's connected to that
6	computer, and then there's also a network server, database server, and data
7	storage unit that are attached to the computer via a network. The network
8	could be, you know, a LAN, it could be the Internet, for example.
9	And a computer has a display portion, a user interface display portion,
10	and it has three components to it, all on one display. The one, there's a
11	document display portion that displays a scanned document. These are all
12	within a browser. There's also another portion that has control elements. So
13	you can actually, within the browser, scan -- cause the computer to issue a
14	signal to the scanner to scan a document, and then that scanned document is
15	captured as data and displayed in the document display portion on the
16	computer.
17	The coder, in other words, the operator of the computer, can then
18	enter indexing data in the box 39, to identify what that document is, or to
19	specify the address at which that document, that scanned document, is to be
20	stored in the remote server. And then the control element could be used also
21	to upload that scanned document to the server for storage.
22	So, if we turn to Figure 3, we see here a display of the browser.
23	You'll see in the lower right-hand side, there is a control element portion of
24	the field. The I-copy button, when you activate it the first time, will cause a
25	document to be scanned. When you activate it at second time, that
26	document will be uploaded from the computer to the remote server for

1   storage, along with any input data that was entered in the field 39. That's

2   called the indexing portion.

3   So, all within one user interface, we see that we have, the document is

4   displaced on the right-hand side, and then we have indexing on the upper,

5   right-hand side, and then on the lower portion, we have control elements that

6   control the behavior of the scanner or the remote server.

7   So now, turning to the actual issues that are the subject of the appeal,

8   one is that we submitted a declaration, establishing conception and reduction

9   to practice, on October 13, 1999. By December 17, 1999, that same

10 declaration that testifies that the bugless for the I-copy product, including

11 many of the claimed futures, was completed by that time.

12   One of the issues in the case is a document called the Quillix. I call it

13 a Quillix I. But it's this document here that says prevalent software

14 introduces Quillix. And in that document, there are some statements that are

15 made. It says that, you know, it's a browser-based, distributed capture

16 solution for the Internet. It's TWAIN-compliant desktop scanners and

17 XML-based Internet forms and runs totally within a browser.

18   It says also that there is no longer a need for disparate scanning and

19 indexing operations for each document and data management system within

20 an organization. And it also says with Quillix, just log on, scan, and release

21 the information to the appropriate document or data management system.

22   So from this, the Examiner has concluded that each and every element

23 of the claimed invention is met by this two-page public press release, and we

24 contend that is an error.

25   For one thing, the Quillix I document doesn't disclose any display

26 portion for displaying the scanned document, as was shown in Figure 3 of

3

1 the application as filed. And that's applicable to Claims 1, 27, 41, 50 and

2 57.

3   And also, that the Quillix also fails to disclose the document display

4 portion, control portion and index portion in separate portions of the same

5 HTML display. So none of that is disclosed --

6   JUDGE SAADAT: Mr. Jurgovan --

7   MR. JURGOVAN: I'm sorry. Go ahead.

8   JUDGE SAADAT: A question. How did this document come into

9 play?

10   MR. JURGOVAN: It was submitted in an information disclosure

11 statement by an Applicant.

12   JUDGE SAADAT: An Applicant?

13   MR. JURGOVAN: Yes. And then the Examiner relied on it, in

14 making a rejection of all of the claims in the application.

15   JUDGE SAADAT: We also notice that this document was relied on

16 to show long-felt need as a secondary consideration --

17   MR. JURGOVAN: Correct.

18   JUDGE SAADAT: -- to overcome 103 rejection.

19   MR. JURGOVAN: Correct.

20   JUDGE SAADAT: And that was when -- that was before the

21 Examiner shifted the rejection and relied on this document.

22   MR. JURGOVAN: The rejection was really shifted from 103 to 102,

23 102(a).

24   JUDGE SAADAT: To 103 from a totally different set of prior art to

25 this document?

4

1   MR. JURGOVAN: Yes, yes. That was early, back in the 2002

2   through 2004 timeframe. The original rejection, it was not based on this

3   document at all. And then we submitted an information disclosure

4   statement, including this document, and the Examiner, in a subsequent

5   action, relied upon it to make a rejection, in part, based on the statement that

6   the Applicant made in connection with the long-felt need in the art.

7   And so that's cool. This is the -- the other thing that is difficult to

8   ascertain is what aspect of 102(a) the Examiner is attempting to rely upon,

9   because this looks to be a publication, although it was picked up by the

10   Wayback Machine in 2001, almost a year -- more than a year after it was

11   actually purported to have been disclosed.

12   And then the other question is what does "introduced" actually mean?

13   That doesn't necessarily mean, you know, offer for sale, or, you know,

14   public use or publicly-known. And so, you know, I've been -- I've had

15   trouble pinning down the Examiner on exactly what aspect of 102(a) is

16   being relied upon in this rejection.

17   Turning to the issue you just mentioned regarding the long-felt need,

18   there was a second publication, it's called Quillix II, and if you look down at

19   the bottom of this document, this is separate from Quillix I, it says it was

20   printed on March 28, 2000. Well, the filing date of this application is

21   February 3, 2000. So this document is not prior art to the subject

22   application.

23   But the Examiner, nonetheless, relies upon all of its features in an

24   attempt to reject the -- all claims of the invention. The Examiner contends

25   that this document also shows all features of the claimed invention. And

26   what the Examiner has tried to do is to tie this later publication to the earlier

1   one, in saying that this disclosure, this publication, in effect, includes both

2   disclosures, even though this one is after the filing date and thus not

3   available as prior art.

4   To do that, the Examiner -- the Applicant made the statement in the

5   May 7, 2004 amendment, "Thus, according to prevalent software, Quillix is

6   the first true enterprise distributed capture system built for the Internet."

7   Further, IBT's president characterizes the Quillix solution as "a

8   revolutionary document and data capture product for the commerce

9   industry."

10   This is further evidence of the long-felt need in the art for the claimed

11   invention to be the first true enterprise data and distributive capture data

12   system built for the Internet and revolutionary. There must have been a

13   long-felt need in the art for the claimed invention, not to mention attempts

14   by others that had failed to attain the claimed invention. But because Quillix

15   appears to contain similar or the same functionality as the claimed invention,

16   it is submitted that there was a long-felt need in the art for the claimed

17   invention that was not satisfied until the invention was made.

18   So the point there that the Applicant is trying to make is that the

19   competitor is making laudatory statements about its product. And to the

20   extent that that product shares features in common with the claimed

21   invention, that is evidence that they thought that the invention was new.

22   Somehow, the Examiner turned that into an admission of prior art.

23   The Examiner contends that basically it is admitted prior art at that point,

24   and freely available to the Examiner to reject the claims.

25   I just want to emphasize that there's no admission of prior art in that

26   statement. The Examiner has failed to take into account, for one thing, that

1 the inventor -- the Applicant could actually have, you know, invented and

2 reduced the invention or practice before the Quillix I publication, which is,

3 in fact, the case, through the declaration that the Examiner failed to consider.

4   JUDGE SAADAT: Can we go back to the statement made by

5 Applicant in the sense of long-felt need. Let's break it down. The Quillix I,

6 if you will, was that what was -- Appellant was relying on to show long-felt

7 need?

8   MR. JURGOVAN: The Quillix -- those quotes, I believe, come from

9 -- yeah, they are actually from Quillix I.

10   JUDGE SAADAT: Okay. So the publication was thought to be

11 relevant and show same -- same or similar functionality.

12   MR. JURGOVAN: In some respects.

13   JUDGE SAADAT: In order to show long-felt need, it must be at least

14 close enough to the invention.

15   MR. JURGOVAN: Yes, but that's to say that it could be close to one

16 of the claims, but maybe not its dependent claims, or, you know, features of

17 its dependent claims may not be covered. In other words, the Examiner took

18 that to be a global statement that all of the claims are admitted prior art. And

19 I don't --

20   JUDGE SAADAT: So maybe Claim 1 is similar?

21   MR. JURGOVAN: It has some aspect -- well, if you look at Quillix

22 II, which again, is not prior art -- and when I look at this display here, I do

23 see that there appears to be, you know, a document being displayed there

24 within a web browser. As far as some of the other functionality, the

25 indexing capability, I don't see it there in one display.

1   So I think there -- even if you look at Quillix I and II together, there's

2 still missing elements. But, on the other hand, it does have, you know, some

3 features that could be regarded as, you know, laudatory aspects of the

4 invention, for -- that satisfy a long-felt need.

5   Okay. So the other issue is that the Applicants, in fact, were the first

6 to invent, as I mentioned. This declaration of Alexandre Okonechnikov

7 establishes concept and reduction to practice before the Quillix I, the

8 January 18, 2000 date of Quillix I. So that is another reason why.

9   Now, the Examiner refused to consider this declaration entirely,

10 stating that the "alleged admission of prior art made it unnecessary to

11 consider this document." So we content that also was error, not to consider

12 this declaration.

13   There's also, you know, an aspect of the best evidence rule here that

14 you can characterize a document in a certain way. But, really, the document

15 itself is the best evidence for what that document discloses. And to look at

16 this document and to ignore the fact that it says that it was printed March 28,

17 2000, after the filing date of the invention of the application, kind of defies

18 the best evidence rule. So we content that's another ground of error.

19   The statement that was made could only be interpreted to say that the

20 claimed invention satisfied a long-felt need in the art, and so, therefore, it

21 wasn't that -- it certainly was not an admission of prior art.

22   Moving on to some of the dependent claims --

23   JUDGE SAADAT: Before you do that, I have a question. This

24 document that you called Quillix II --

25   MR. JURGOVAN: Yes.

1   JUDGE SAADAT: -- and it seems like it has a label at the bottom,

2 printed March --

3   MR. JURGOVAN: -- 28th, 2000.

4   JUDGE SAADAT: -- 28th, 2000, was that also submitted with an

5 IDS?

6   MR. JURGOVAN: Yes, it was.

7   JUDGE SAADAT: So Applicant knows where -- or what the source

8 of it was. Was it like presented in a convention or what --

9   MR. JURGOVAN: I don't recall, specifically, how we found that

10 document. It probably was found somewhere on the Internet, and, you

11 know, determined to be relevant enough that it should be submitted in an

12 intervention closure statement.

13   JUDGE SAADAT: The reason I ask is that the appearance of the

14 document seems -- at least maybe it made the Examiner think it is part of a

15 larger disclosure.

16   MR. JURGOVAN: Ah, no, I don't think it was.

17   JUDGE SAADAT: No? Okay.

18   MR. JURGOVAN: I think this is it.

19   JUDGE SAADAT: Okay.

20   MR. JURGOVAN: But what you -- it's basically a data sheet release

21 that we got off of the Internet, I believe.

22   So, turning to one of the dependent claims, Claims 2 and 23

23 specifically recite this control element that has differing functions when you

24 activate it. So you activate it the first time. That causes the computer to

25 issue the signal to the scanner, to cause it to scan a document. You activate

1   that same control element a second time and it actually uploads that

2   document to a remote server.

3   And what's good about that is that coders are paid by the document

4   coded. For example, in medical coding, coding of medical documents, x-

5   rays, you know, doctor's statements, and so forth, all of that is -- can be done

6   more quickly if one doesn't have to switch between screens, as one is doing

7   this coding work. So speed is of the essence in coding, and this is a feature

8   that enables a coder to code relatively quickly, and therefore, you know, to

9   make greater income in a shorter period of time.

10   So the Examiner made an official notice statement early in the

11   prosecution. I believe that was in the 10-13-2004 amendment. And then

12   contended that statement was not traversed and a formal request for a

13   document was not made, and so, therefore, it was basically an admission, an

14   official notice that it was not traversed, and therefore, an admission.

15   If we look at MPP-214403, it says that official notice, unsupported by

16   documentary evidence, should only be taken by the Examiner where the

17   facts are asserted to be well-known or to be common knowledge in the art or

18   capable of incidents and unquestionable demonstration as being well-known.

19   That's from the *In re Ahlart* case, citing *Knappmonarch Company*.

20   And so, official notice is appropriate only in rare instances in which

21   the facts asserted to be true are capable of unquestionable demonstration as

22   to their truth.

23   The Examiner took official notice that a control element used to

24   alternately generate a start-scan signal and a send-data signal with

25   successive activations of the control element in a user interface was well-

1 known in the art at the time the invention was made, as a user interface
2 widget known as the toggle button.
3   So that statement by the Examiner is, on its face, implausible, that
4 such a control element, as defined, that sends a start-scan signal and then
5 sends a send-data signal with successive activations, that is something that is
6 well-known in the art. It certainly is not. So we feel that the Examiner was
7 in error to even assert official notice in the first place. And if we look at the
8 record, we'll see that, you know, the Examiner used official notice very
9 liberally, too liberally, and we think that was in error, as well.
10   The other issue is that the Examiner is contending that official notice
11 was not traversed. If we look at the 2-14-2005 amendment on page 40, it
12 says, "the taking of judicial notice is respectfully traversed." Since the
13 bulletin, the IBM bulletin, does not provide support for the proposition for
14 which judicial notice has been taken, namely, that the toggle buttons were
15 alternately generating a start-scan signal to scan a document with a scanner
16 and a send-data signal to send document data and index data to a server over
17 a network for storage, were known to those of ordinary skill in the art as of
18 the filing date of the claimed invention.
19   JUDGE SAADAT: But didn't the Examiner finally provide a
20 reference to show that it was a known feature?
21   MR. JURGOVAN: Yes, that's true. And but still contending that,
22 you know, the official notice was not traversed, and so, therefore, you know,
23 any argument that we would make, he would not consider at that point.
24   You know, the point here is that official notice was traversed on the
25 record. And then, secondly, what the Examiner did is to find a toggle button
26 that has an on/off function. And so, what the Examiner has done is to

1   engage in claim dissection, is not considering the invention as a whole as

2   required by 103(a). The Examiner has pulled out an element and attempted

3   to say well this is a toggle button that turns on and off, but that's not what

4   the claimed invention says. What is says is it's a control element that with

5   successive activations generates a start-scan signal and then generates a

6   send-data signal, so --

7   JUDGE SAADAT: All right. So that's a button, for example, by

8   pressing once it would perform function one, second press, function two.

9   MR. JURGOVAN: Yes.

10   JUDGE SAADAT: Third press would go to function one?

11   MR. JURGOVAN: Right, exactly.

12   JUDGE SAADAT: So isn't that a toggle?

13   MR. JURGOVAN: Yes, but it's -- that's not -- it doesn't turn on and

14 off. It --

15   JUDGE SAADAT: It's a different function.

16   MR. JURGOVAN: It does one thing or the other. And so, what I'm

17 saying is that the Examiner has kind of extracted this element from the

18 context of the claim and said I've got you because I found this toggle button

19 that turns on and off, but that's -- the claim specifically is directed to a

20 control element that does these specific -- that generates a start-scan signal,

21 to cause a scanner to scan a document, and then on the next activation, it

22 generates a send-data signal, to send that document to a remote server for

23 storage. That's a specific context in which this control element is being

24 claimed that the Examiner has tried to abstract in a way that 103(a) does not

25 allow because it requires consideration of the claim as a whole.

1   JUDGE SAADAT: But the way we understood the Examiner's

2 position was the Examiner took the functionality of scan-send to be like

3 function one, function two, and the button or switch would toggle between

4 those two functions. Could -- again, that's how we understood the

5 Examiner's position to be …

6   MR. JURGOVAN: Correct.

7   JUDGE SAADAT: That any function could be assigned to those two

8 situations. Could -- the scan-send could be scan-store? So it's up to the

9 designer what functions are used. So that's how we understood Examiner's

10 -- or why the Examiner separated those functions from just the toggle.

11   MR. JURGOVAN: But the actual document that's being relied on by

12 the Examiner just states that it's a toggle button for turning on and off. And

13 so, on and off is not start scan, send data.

14   JUDGE SAADAT: But they're two different -- I mean, these are

15 different signals, actually.

16   MR. JURGOVAN: Yeah, correct.

17   JUDGE SAADAT: Isn't that true?

18   MR. JURGOVAN: Correct, but they do -- in the claimed context,

19 they do something, turning on and off in the abstract.

20   JUDGE SAADAT: Okay.

21   MR. JURGOVAN: There's no -- there's insufficient motivation to

22 really get the person of ordinary skill in the art to get from those two

23 disclosures to the on-off toggle button being start scan, send data. That's,

24 you know, our contention.

25   JUDGE SAADAT: Right.

1   MR. JURGOVAN: The nonfunctional descriptive material rejection,

2 with respect to Claim 63, Claim 63 depends from Claim 60, which is another

3 dependent claim, and it says "inputting index data," and what Claim 63 says

4 is that input data specifies the path at which document data is to be stored.

5   The Examiner contends that this is merely descriptive material, the

6 nature of that data that's input is descriptive material. We maintain that the

7 contention that that is a further limitation of the index data that is physically

8 input into the index fields. So, when we're actually specifying a file path in

9 that index field, it's not like it's text in the abstract. It is functional data that

10 is being input into the field and it's there for subject matter that could be

11 protected through the patent laws.

12   And then, finally, the objective evidence of nonobviousness. We've

13 submitted a lot of declarations on the record from various customers and so

14 forth, a lot of different evidence, and we feel that was not given adequate

15 weight, or, in some cases, any weight, as in the case of the declaration of

16 Alexandre Okonechnikov, which established conception and reduction of

17 practice before the filing date -- for before, rather, Quillix I, on January 18th,

18 2000.

19   So that pretty much concludes, you know, some of the major points I

20 wanted to make today. And I really appreciate your time.

21   JUDGE SAADAT: Any questions?

22   JUDGE KRIVAK: I don't have any questions.

23   MR. JURGOVAN: Great.

24   JUDGE SAADAT: Thank you.

25   MR. JURGOVAN: I really appreciate it. Thank you. It's great to see

26 you again, Carla.

1   JUDGE KRIVAK: You, too, Jon.

2   MR. JURGOVAN: Thanks very much.

3   JUDGE SAADAT: You're welcome.

4   (Whereupon, the proceedings, at 9:37 a.m., were concluded.)